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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,944	01/22/2002	Russell A. Houser	13513-006001	1973

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EXAMINER

PHAN, HAU VAN

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/050,944

Applicant(s)

HOUSER ET AL.

Examiner

Hau V Phan

Art Unit

3618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13,15-21,25-36 is/are pending in the application.
- 4a) Of the above claim(s) 26-29 and 31-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13,15-21,25,30,35 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of figures 3m-3n, claims 13, 15-21, 25, 30, 35-36 in Paper No. 12 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 26-29, 31-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 12.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 5/8/2003 has been considered.

Acknowledgment

4. The preliminary amendment filed on 5/8/2003 has been entered.
5. The request for extension filed on 1/5/2004 has been considered.

Claim Objections

6. Claim 15 is objected to because of the following informalities: The phrase "as a bottom" should be changed to – at a bottom --. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 13, 15-21, 25-30 and 35-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Regarding claims 13, 15-21, 25-30 and 35-36, the phrase "or" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or "), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. **Claims 13, 15-21, 25, 30 and 35-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Julien (6,267,402).**

Julien in figures 1-2, discloses a ski having a superelastic components (32, 34), which configured and positioned with respect to the ski to provide an elastic response of the ski to a deflection.

Regarding claims 15-16, Julien in figure 5 discloses the ski having a superelastic component (95), which is positioned at a bottom surface of the ski. Wherein the bottom surface of the ski is configured to be in contact with a ski surface. The superelastic has a curvature between opposite outside edges.

Regarding claims 17 and 25, Julien in figure 6 discloses a superelastic component (110) having a flat surface between opposite outside edges. The superelastic component attaches to a bottom surface of the ski at a position between the opposite outside edges.

Regarding claim 18, Julien discloses the superelastic component, which is removably mounted to the ski (col. 4, lines 40-45).

Regarding claim 19, Julien discloses the superelastic component, which is positioned at least partially within the ski (as shown in figure 1).

Regarding claims 20-21, Julien in figure 3, discloses superelastic components (100), which are positioned along each longitudinal edge of the ski that can be considered two parallel members. The superelastic members extend collinear along at least a portion of the length of the ski.

Regarding claim 30, Julien discloses the superelastic component comprising nitinol.

Regarding claim 35, Julien in figure 3 discloses a ski (45) comprising a housing and one or more superelastic components (100) extending outwardly and downwardly from the housing. The superelastic being positioned on opposite edges of the ski and extending outwardly beyond the housing, wherein the superelastic components deflect in response to an application of a force to one or more of the superelastic components.

Regarding claim 35, Julien discloses the superelastic component comprising nitinol.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Legrand et al. disclose a ski and method of making same, Koleda discloses a vibration damping units, Pascal et al. disclose a ski with distributed shock absorption, Mayr discloses a ski comprising damping layers and Franco et al. disclose a vibration damper device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hau V Phan whose telephone number is 703-308-2084. The examiner can normally be reached on 7:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson can be reached on 703-308-0885. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HP

Hauphan
2/29/04

HAUPHAN
PATENT EXAMINER